



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/612,784

07/02/2003

Ray C. Wasielewski

ORW01-GN004

5434

30074

7590

10/24/2006

TAFT, STETTINIUS & HOLLISTER LLP
SUITE 1800
425 WALNUT STREET
CINCINNATI, OH 45202-3957

EXAMINER

SNOW, BRUCE EDWARD

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

NI

Office Action Summary	Application No.		Applicant(s)	
	10/612,784		WASIELEWSKI, RAY C.	
	Examiner		Art Unit	
	Bruce E. Snow		3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-90 is/are pending in the application.
- 4a) Of the above claim(s) 17, 18, 38, 39, 69, 70, 80, 81, 89 and 90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 19-37, 40-68, 71-79 and 82-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/25/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 8/25/06 have been fully considered. Regarding the rejection under 35 U.S.C. 102(e) as being anticipated by McGann (6,228,122), applicant's amendments and arguments have overcome said rejection.

Note claims 69 and 70 should be labeled "withdrawn".

Information Disclosure Statement

The information disclosure statement filed 8/25/06 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

No copy of PCT/US03/10950 was found.

Specification

The amendment filed 8/25/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Proposed new figure 10 introduces new augments 26d which have a height greater than width length unlike the original figures. The new configuration is new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: curb.

Objection to the drawings

The drawings fail to show all the constraining augments are adapted to be fastened to the "acetabular cavity within a hip bone" or "positionable about a femoral member". Additionally, please direct to the specification for support.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims are 27-36, 40-42, 46, 47, 51, 54-66, 71-78 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kuber (DE 19716051, applicant submitted).

73. (CURRENTLY AMENDED) A constraining device for, at least temporarily, promoting engagement of a prosthetic femoral stem component with a prosthetic acetabular component of a prosthetic hip assembly, the constraining device comprising a segment A of material selected from the group consisting of a biologic material, a biologically absorbable material, and a combination of biologic and biologically absorbable materials, the segment forming a partial circumferential curb adjacent to the prosthetic acetabular component and allowing rotational and angular movement between the acetabular cup assembly and the femoral stem. See integrated fastener C.

Regarding claim 54, Kuber teaches "the ring is made in thicknesses of $\frac{1}{2}$ and 1 cm", therefore, a plurality. The segments can define a ring which is interpreted as functional language in the dependent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 19-26, 37, 43-45, 48-50, 52, 53, 67, 68, 79, 82-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuber (DE 19716051, applicant submitted).

Kuber teaches the augment as claimed but fails to it extends 180 degrees or less. It would have been obvious to one having ordinary skill in the art to have made the augment of Kuber into multiple separate parts or sized smaller such that the surgeon could place the augment(s) only where deemed necessary for the patient introducing less foreign matter into said patients body. MPEP 2144 states: The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. See MPEP 2144.04 IV (A) Changes in size/proportion and (C) Making Separable.

Regarding, for example claim 1, augment material is supplemented with an agent to promote formation of scar tissue, Kuber teaches the augment is made from PLLA which is bioresorbable and is "transformed into flexible native connecting tissue"

Art Unit: 3738

interpreted as scar tissue. It would have been obvious to one having ordinary skill in the art to have utilized any of the known bioresorbable materials or combinations thereof (the second material being the agent) which all result into scar tissue because they would have performed equally well and wherein the time of resorbability could be controlled.

Regarding claim 67, (or any other claim with this limitation) at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to snap-on retention members. Applicant has not disclosed that said configuration provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either screws or a snap-on configuration. Therefore, it would have been obvious to one of ordinary skill in the art to modify Kuber to obtain the invention as claimed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3738

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bes



BRUCE SNOW
PRIMARY EXAMINER